

REMARKS

I. Summary of Office Action

Claims 1-15, 18, 19 and 22-46 have been rejected under 35 U.S.C. § 112, second paragraph, for failing to point out particularly and distinctly claim the subject matter which applicant regard as the invention.

Claims 1, 2, 5-8, 29, 30 and 33-36 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Gomersall et al. U.S. Patent No. 4,500,880 (hereinafter "Gomersall"). Claims 1-13, 16-26, 29-35, 38-55 and 58-64 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Fitch U.S. Patent No. 5,912,653 (hereinafter "Fitch"). Claims 14, 15, 27, 28, 36, 37, 56 and 57 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Fitch.

II. Summary of Reply to Office Action

Claims 1, 9, 29, 40, 47 and 58 have been amended to point out more particularly and distinctly claim the invention. Claims 65-84 have been added. The claims amended and added are fully supported and justified by the application as originally filed.

Applicant respectfully traverses the rejections under 35 U.S.C. § 112, second paragraph, and 35 U.S.C. §§ 102 and 103.

III. Reply to Rejection under 35 U.S.C. § 112

Claims 1-15, 18, 19 and 22-46 have been rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which applicant regard as the invention. Applicant traverses these rejections for the reasons set forth below.

A. Claim 1

The Office Action rejected claim 1 contending that "the recitation 'wherein the electronic display is not associated with the inherent function of the product' is indefinite since information about a product is 'associated' with the function of the product" (Office Action, page 2). Applicant's claims, however, require that that the "electronic display is not associated with the inherent function of the product." An exemplary passage from the specification that supports this claim language is at page 3, lines 14-22. Applicant states in this portion of the specification, *inter alia*, that many products include a display as an inherent function of the product. An example of such a product having an inherently functional display is a digital watch that shows the time of day.

In contrast, applicant's invention is directed to the display of information that is not associated with the inherent function of the product. An illustrative example of such a label is one, attached to a piece of luggage, that displays information identifying the manufacturer of the luggage. The inherent function of luggage is to carry clothing and other personal effects. Displaying such information (i.e., identification of the manufacturer) is therefore not associated with the inherent functionality of the luggage.

The Office Action further rejected claim 1 stating that "the recitation 'wherein the information is about the product' is indefinite since the product is not even being claimed as part of the invention" (Office Action, page 2). Applicant respectfully disagrees that this feature is indefinite. The product is clearly claimed

as part of applicant's claim 1 in that the "base [is] adapted to be affixed to said product." The reference to the "product" describes the context or setting in which applicant's invention is used. The product itself is not claimed. Rather, the reference to the product defines the type of information that is displayed. Applicant submits that this feature particularly points and distinctly claims the invention because it is satisfied only if the information displayed is "about the product" to which the label is attached, and is not satisfied if the information displayed is not about that product.

Accordingly, applicant submits that the rejection of claim 1 under 35 U.S.C. § 112, second paragraph, should be withdrawn.

B. Claim 9

The Office Action rejected claim 9 contending that "the recitation 'wherein the electronic display is not associated with the inherent function of the product' is inaccurate and indefinite since in the body of the claim applicant sets forth the step of 'attaching an electronic display to the product' and thus such display is in fact part of the product. Furthermore the information about the product is clearly 'associated' with the inherent function of the product." (Office Action, page 2). Applicant respectfully disagrees.

Whether or not the electronic display is considered to be "part of the product" is irrelevant into the question of definiteness and accuracy. Moreover, the claim specifically refers to the "electronic display" and the "product" as separate items. The attachment of the electronic label to the product provides a context for the type of information shown by the display, as the

information must be "about the product." As stated above in connection with claim 1, a product may include a display that is inherent to the product's function (e.g., displaying the time of day for a digital watch). The electronic display of applicant's invention, however, is not used for the product's inherent function, but rather to display information "about the product" (e.g., "source information").

Additionally, displaying information "about the product" is not the inherent function of the product. As explained above for claim 1, applicant submits that this feature particularly points out and distinctly claims the invention because it is satisfied only if the information displayed is "about the product" to which the label is attached, and is not satisfied if the information displayed is not about that product.

Accordingly, applicant submits that the rejection of claim 9 under 35 U.S.C. § 112, second paragraph, should be withdrawn.

C. Claim 29

The Office Action rejected claim 29 contending that "the recitation 'information comprising label information, product information or source information' is indefinite since the product is not even being claimed as part of the invention" (Office Action, page 2). Applicant submits that for at least the reasons set forth above in connection with claim 1, the rejection of claim 29 under 35 U.S.C. § 112, second paragraph should be withdrawn.

IV. Reply to Rejection under 35 U.S.C. § 102

Each of applicant's independent claims 1, 9, 29 and 47 relates to a label for a product or a method for

labeling a product. Common to all of applicant's independent claims is an electronic display that is affixed to a product. In independent claims 1 and 9, the electronic display is not associated with the inherent function of a product. The electronic display of independent claims 1 and 9 is programmed to show information about the product, and the displayed information is animated.

In independent claims 29 and 47, the electronic display is programmed to output information comprising "product information" or "source information." As defined in applicant's specification at, e.g., page 3, line 23 to page 4, line 4, "'product information' means information about the features, use, or care of the product to which the label is attached. 'Source information' means information concerning the manufacturer, seller, or source of the product, such as an address (including an e-mail address) or telephone number for contacting the company, or an address of a web page for finding additional information about the company and its products."

A. Gomersall

The Office Action rejected independent claims 1 and 29, contending that these claims are anticipated by Gomersall. Applicant respectfully disagrees.

Gomersall is directed towards a retail pricing display system which displays the prices of items on a shelf or bin (see Gomersall, column 2, lines 8-15). Gomersall's display system includes a display module that is mounted to shelves so that the information displayed, such as pricing information, corresponds to the items displayed on the shelf (see Gomersall, column 4, lines 30-35 and FIG. 3).

The Office Action, citing Ex parte Masham, contends that the display module in Gomersall "clearly has the capability of being adapted to be fixed to a product and whether it actually is, or might be, used in such a manner depends upon the performance of a future act of use rather than a structural distinction in the claims" (Office Action, pages 3-4). Applicant respectfully disagrees.

Ex parte Masham requires that "the prior art apparatus teaches all the structural limitations of the claim" (MPEP 2115, see also Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987)). Applicant submits that the display module in Gomersall does not anticipate applicant's claims because it is not adaptable to be affixed to anything but a shelving-type apparatus. Gomersall states that display module "may be attached to the edge of shelving in any suitable way" (Gomersall, column 4, lines 50-51). Gomersall's statement shows that its invention does not contemplate attaching the display to anything but shelving or possibly other types devices for displaying products for sale. Attachment of a display device to shelving for displaying products versus attachment to the products themselves is a clear structural distinction.

Applicant's claims 1 and 29 are patentable over Gomersall for a separate and independent reason. Claims 1 and 29 require that the electronic display is attached to the product, by way of a "base." Because the display module of Gomersall is attached to the shelving, the "product" in Gomersall must be the shelving itself. Under this arrangement, Gomersall still fails to satisfy all aspects of applicant's claims. The electronic display of applicant's claims 1 and 29 require that the information displayed is about the product. Therefore, in order for

Gomersall to anticipate applicant's claim, the display module would have to display information about the shelf. Gomersall, however, does not disclose that the display module displays information about the shelf. Rather, it provides pricing information about the items that are on the shelf.

Finally, an additional requirement of claim 1 is that the information displayed is animated. Gomersall neither shows nor suggests that the information displayed is animated.

Therefore, for at least the foregoing reasons, the rejection of independent claims 1 and 29, as being anticipated by Gomersall, should be withdrawn.

B. Fitch

The Office Action rejected independent claims 1, 9, 29 and 47 contending that these claims are anticipated by Fitch. Applicant respectfully disagrees.

Fitch is directed towards a liquid crystal display ("LCD") displaying images on a garment used to "express oneself and to some extent separate oneself from others. . ." (Fitch, column 1, lines 8-22). The images displayed on the LCD are described as being related to the environment, mood, ambience or setting in which the garment is worn (see Fitch, column 4, lines 17-29). Applicant respectfully submits that the information displayed in Fitch is not "about the product," as required by independent claims 1 and 9. Moreover, applicant submits that the information displayed in Fitch is not "product information" or "source information," as required by independent claims 29 and 47.

Each of applicant's independent claims requires that the information displayed by the label relates to the

product to which the label is attached. Fitch does not show or suggest that the LCD that is attached to the garment displays information that relates to the garment. Rather, the information displayed in Fitch concerns only a form of personal or environmental expression.

Finally, an additional requirement of claims 1 and 9 is that the information displayed is animated. Fitch neither shows nor suggests that the information displayed is animated.

At least for the foregoing reasons, the rejection of independent claims 1, 9, 29 and 47 as being anticipated by Fitch should be withdrawn.

V. Dependent Claims

Claims 2-8, 10-15, 18, 19, 22-28, 30-42, 44-46, 48-60 and 62-90 are dependent from at least one of allowable independent claims 1, 9, 29 and 47 and are allowable at least because claims 1, 9, 29 and 47 are allowable.


VI. Request for Signed Form PTO-1449

Applicant has not yet received signed copies of the Form PTO-1449 of Information Disclosure Statements filed April 14, 2004 and August 11, 2004. Applicant requests that signed copies of the Form PTO-1449 be returned with the next Office Action.

VII. Conclusion

The foregoing demonstrates that applicant's claims 1-15, 18, 19, 22-42, 44-60 and 62-90 are patentable. This application is therefore in condition for allowance. Reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,



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